



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/901,947 | 07/10/2001 | Gerald L. Jenkins | 7663/82744 | 9222 |

24628 7590 09/17/2004

WELSH & KATZ, LTD
120 S RIVERSIDE PLAZA
22ND FLOOR
CHICAGO, IL 60606

EXAMINER

PARTON, KEVIN S

ART UNIT PAPER NUMBER

2153

DATE MAILED: 09/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|------------------------------------|--|
| Office Action Summary | Application No. 09/901,947 | Applicant(s) JENKINS, GERALD L. | |
| | Examiner Kevin Parton | Art Unit 2153 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/10/01
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 17-23 and 25-27 is/are rejected.
- 7) ☒ Claim(s) 16 and 24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>01/29/02</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because figures 2, 3, and 4 all contain text that is illegible. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 5 recites the limitation "the email" in lines 9-10. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 2153

6. Claims 1-3, 6, 8, 12-14, 17, 19-22, 25, and 27 are rejected under 35

U.S.C. 102(b) as being anticipated by Ronen (USPN 5,845,267).

7. Regarding claims 1 and 12, Ronen (USPN 5,845,267) teaches a system for enabling a server to contact an unknown Internet account holder with means for:

- a. Receiving a notice from the server via a standardized communication pathway, the notice comprising a request time and a requesting IP address, and a communication (column 7, line 65 – column 8, line 1; column 5, lines 38-40).
- b. Identifying the account holder based on the requesting IP address and optionally the request time (column 8, lines 1-4).
- c. Sending the account holder the communication by an arranged manner (column 8, lines 24-29).
- d. Wherein the server need not know the identity of the account holder, and the notice need not contain information regarding the identity of the account holder (column 7, line 65 – column 8, line 1; column 5, lines 38-40). Please note that the server (merchant ISP) only has the IP address of the request. The transaction server and billing server correlate this to a user ID, the merchant server never sees the user ID.

8. Regarding claims 2 and 13, Ronen (USPN 5,845,267) teaches all the limitations as applied to claims 1 and 12, respectively. He further teaches means wherein the step of identifying the account holder comprises checking a list of static IP addresses (column 5, lines 46-48).

Art Unit: 2153

9. Regarding claims 3, 14, and 22, Ronen (USPN 5,845,267) teaches all the limitations as applied to claims 1, 12, and 21, respectively. He further teaches means wherein the arranged manner is selected from the group consisting of email, fax, voice, standard mail, and destruction (column 7, line 65 – column 8, line 1; column 5, lines 38-40). Note that the billing server would notify the user, if a credit card were billed, standard mail would be used to send the bill.

10. Regarding claims 6, 17, and 25, Ronen (USPN 5,845,267) teaches a system for enabling a server to contact an unknown Internet account holder with means for:

- a. Receiving a request for a resource (column 7, lines 65-66).
- b. Determining that the request for the resource warrants sending a notice (column 7, line 65 – column 8, line 1). Please note that the transaction server determines this and forwards a message to the session server.
- c. Identifying a notice destination to which the notice is to be sent (column 8, lines 4-10). The session server is the destination in this case.
- d. Generating a notice comprising an apparent IP address, a time the server received the request, and a communication (column 8, lines 4-10). The transaction server queries the session server.
- e. Sending the notice to the notice destination via a standardized communications pathway (column 8, lines 4-10). The request is sent to the session server.

Art Unit: 2153

11. Regarding claim 8, Ronen (USPN 5,845,267) teaches all the limitations as applied to claim 6. He further teaches wherein the server is a web server that is sending a response to a http request (figure 1, element 121; column 8, lines 4-10).
12. Regarding claims 19 and 27, Ronen (USPN 5,845,267) teaches all the limitations as applied to claims 17 and 25. He further teaches wherein the resource is an http resource (figure 1, element 121; column 8, lines 4-10).
13. Regarding claim 20, Ronen (USPN 5,845,267) teaches a system for enabling a server to contact an unknown Internet account holder comprising:
 - a. A standardized communication pathway server capable of receiving a notice (column 7, line 65 – column 8, line 1; column 5, lines 38-40
 - b. A parser capable of identifying a request time, a requesting IP address from the notice and communication within the notice (column 8, lines 1-4).
 - c. A login database comprising IP addresses, request times, and accounts (column 4, line 63 – column 5, line 1).
 - d. Account holder communication subsystem for sending the account holder the communication (column 8, lines 24-29).
 - e. Wherein the server need not know the identity of the account holder, and the notice need not contain information regarding the identity of the account holder (column 7, line 65 – column 8, line 1; column 5, lines 38-40). Please note that the server (merchant ISP) only has the

IP address of the request. The transaction server and billing server correlate this to a user ID, the merchant server never sees the user ID.

14. Regarding claim 21, Ronen (USPN 5,845,267) teaches all the limitations as applied to claims 1 and 12, respectively. He further teaches means wherein the login database comprises a list of static IP addresses (column 5, lines 46-48).

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 4, 11, 15, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ronen (USPN 5,845,267) in view of Grassle (USPN 6,785,824).

17. Regarding claim 4, Ronen (USPN 5,845,267) teaches all the limitations as applied to claim 1. He further teaches means for checking one or more files comprising a database comprising dynamic IP addresses, accounts, and times, and the request time is the time at which the server received the requests (column 8, lines 1-4).

Although the system disclosed by Ronen (USPN 5,845,267) shows substantial features of the claimed invention, it fails to disclose specifically means wherein the communication pathway is email.

Nonetheless, these features are well known in the art and it would have been an obvious modification of the system disclosed by Ronen (USPN 5,845,267), as evidenced by Grassle (USPN 6,785,824).

Art Unit: 2153

In an analogous art, Grassle (USPN 6,785,824) discloses a system for sending messages based on Internet usage wherein the communication pathway is email (figure 2, element 108).

Given the teaching of Grassle (USPN 6,785,824), a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Ronen (USPN 5,845,267) by employing email for contacting a user. This is a common form of communication on the Internet and benefits the system by making the message immediately available to a user.

18. Regarding claim 11, although the system disclosed by Ronen (USPN 5,845,267) (as applied to claim 6) shows substantial features of the claimed invention, it fails to disclose specifically means wherein the standardized communication pathway is email.

Nonetheless, these features are well known in the art and it would have been an obvious modification of the system disclosed by Ronen (USPN 5,845,267), as evidenced by Grassle (USPN 6,785,824).

In an analogous art, Grassle (USPN 6,785,824) discloses a system for sending messages based on Internet usage wherein the standard communication pathway is email (figure 2, element 108).

Given the teaching of Grassle (USPN 6,785,824), a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Ronen (USPN 5,845,267) by employing email for contacting a user. This is a common form of communication on the Internet and benefits the system by making the message immediately available to a user.

Art Unit: 2153

19. Regarding claim 15, Ronen (USPN 5,845,267) teaches all the limitations as applied to claim 12. He further teaches means for identifying an account holder using dynamic IP addresses, accounts, and times, and the request time is the time at which the server received the requests (column 8, lines 1-4).

Although the system disclosed by Ronen (USPN 5,845,267) shows substantial features of the claimed invention, it fails to disclose specifically means wherein the standardized communication pathway is email.

Nonetheless, these features are well known in the art and it would have been an obvious modification of the system disclosed by Ronen (USPN 5,845,267), as evidenced by Grassle (USPN 6,785,824).

In an analogous art, Grassle (USPN 6,785,824) discloses a system for sending messages based on Internet usage wherein the standardized communication pathway is email (figure 2, element 108).

Given the teaching of Grassle (USPN 6,785,824), a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Ronen (USPN 5,845,267) by employing email for contacting a user. This is a common form of communication on the Internet and benefits the system by making the message immediately available to a user.

20. Regarding claim 23, Ronen (USPN 5,845,267) teaches all the limitations as applied to claim 21. He further teaches means wherein the login database comprises dynamic IP addresses, accounts, and times (column 8, lines 1-4).

Although the system disclosed by Ronen (USPN 5,845,267) shows substantial features of the claimed invention, it fails to disclose specifically means wherein the standardized communication pathway server is an email server.

Nonetheless, these features are well known in the art and it would have been an obvious modification of the system disclosed by Ronen (USPN 5,845,267), as evidenced by Grassle (USPN 6,785,824).

In an analogous art, Grassle (USPN 6,785,824) discloses a system for sending messages based on Internet usage wherein the standardized communication pathway server is an email server (figure 2, element 108).

Given the teaching of Grassle (USPN 6,785,824), a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Ronen (USPN 5,845,267) by employing email for contacting a user. This is a common form of communication on the Internet and benefits the system by making the message immediately available to a user.

21. Claims 7, 10, 18, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ronen (USPN 5,845,267) in view of McClain et al. (USPN 6,722,214).

22. Regarding claims 7, 18, and 26, although the system disclosed by Ronen (USPN 5,845,267) (as applied to claims 6, 17, and 25, respectively) shows substantial features of the claimed invention, it fails to disclose means for warning a user that fulfilling the request for a resource will result in the sending of a notice.

Nonetheless, these features are well known in the art and it would have been an obvious modification of the system disclosed by Ronen (USPN 5,845,267), as evidenced by McClain et al. (USPN 6,722,214).

In an analogous art, McClain et al. (USPN 6,722,214) discloses a system for evaluating web requests with means for warning a user that fulfilling the request for a resource will result in the sending of a notice (column 11, lines 20-25).

Given the teaching of McClain et al. (USPN 6,722,214), a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Ronen (USPN 5,845,267) by employing the warning of users that a notice may be sent. This benefits the system by allowing a user to choose not to access content or purchase something if it is known that charges will be incurred or if the material is inappropriate.

23. Regarding claim 10, although the system disclosed by Ronen (USPN 5,845,267) (as applied to claim 8) shows substantial features of the claimed invention, it fails to disclose means wherein the response to the hypertext transfer protocol request contains hypertext code that enables a caching server to send notices on behalf of the server.

Nonetheless, these features are well known in the art and it would have been an obvious modification of the system disclosed by Ronen (USPN 5,845,267), as evidenced by McClain et al. (USPN 6,722,214).

In an analogous art, McClain et al. (USPN 6,722,214) discloses a system for evaluating web requests wherein the response to the hypertext transfer protocol request

Art Unit: 2153

contains hypertext code that enables a caching server to send notices on behalf of the server (abstract; column 11, lines 20-25).

Given the teaching of McClain et al. (USPN 6,722,214), a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Ronen (USPN 5,845,267) by employing a cache server that can send messages in place of the origin server. This benefits the system by ensuring that cached data is protected from inappropriate access or charges even though it is not newly downloaded from the server.

24. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ronen (USPN 5,845,267) in view of Forlenza et al. (USPN 6,725,380).

25. Regarding claim 9, although the system disclosed by Ronen (USPN 5,845,267) (as applied to claim 8) shows substantial features of the claimed invention, it fails to disclose means wherein the response to the hypertext transfer protocol request contains hypertext code that aids in preventing the caching of the Web page.

Nonetheless, these features are well known in the art and it would have been an obvious modification of the system disclosed by Ronen (USPN 5,845,267), as evidenced by Forlenza et al. (USPN 6,725,380).

In an analogous art, Forlenza et al. (USPN 6,725,380) discloses a system for ensuring security in Internet usage wherein the response to the hypertext transfer protocol request contains hypertext code that aids in preventing the caching of the Web page (column 7, lines 16-21).

Given the teaching of Forlenza et al. (USPN 6,725,380), a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Ronen (USPN 5,845,267) by preventing the caching of some content. This benefits the system by protecting the user from future accesses of inappropriate or personal information.

Allowable Subject Matter

26. Claims 16 and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

27. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please see the following:

- a. Blackshear et al. (USPN 6,013,107)
- b. Bartoli et al. (USPN 6,047,268)
- c. Sitaraman et al. (USPN 6,427,170)
- d. Das et al. (USPN 6,742,036)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Parton whose telephone number is (703)306-0543. The examiner can normally be reached on M-F 8:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on (703)305-4792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2153

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kevin Parton
Examiner
Art Unit 2153

ksp



FRANTZ B. JEAN
PRIMARY EXAMINER